

Appl. No. 10/797,346  
Response Dated May 17, 2007  
Reply to Office Action of April 23, 2007

PATENT

Amendments to the Claims:

There are presently no amendments to the claims.

REMARKS/ARGUMENTS

In response to the Office action mailed April 23, 2007 **Applicants elect with traverse Group I**, drawn to a method for transforming *Parthenium argentatum* (Guayule) utilizing *Agrobacterium*, including said method utilizing controlled light conditions. In particular, Applicants traverse the restriction between Groups I and II and initially request that Groups I and II be examined together. The claims of Group II are drawn to a transgenic Guayule line, produced by the process set forth in the claims of Group I.

Where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions (MPEP §803). In establishing that an "undue burden" exists for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP §808.02).

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* showing of serious burden. Group II is purportedly distinct from Group I because the transformed product of Group II has been classified in a different subclass - 298. However, separate classification alone does not constitute restriction nor an undue burden. The MPEP cites that classification **and** field of search are the determining factors (see MPEP 808.02(A)(C)). Divergent classification may exist within the same field of search (emphasis added). In the instant case, the transformed Guayule of Group II is specifically obtained via the process set forth in Group I, resulting in shoot elongation and rooting, as such the field of search of the

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transformed product would necessarily include the purported method which confers certain features to the plant.

The examiner cites that the search would be independent for Groups I and II because the method of Group I utilizes *Agrobacterium* and controlled light conditions whereas invention II will require searching the literature for "transgenic" Guayule plants. Both inventions I and II are drawn to the use of *Agrobacterium* and controlled light conditions to transform a gene into Guayule. Although Groups I and II contain the same claim language with regard to transformation, the examiner appears to distinguish the inventions based on the presence of the term "transgenic" in group II. Transformation is a tool for creating a transgenic product. The state of the art recognizes that a product obtained by transformation with a gene product is in fact a transgenic product; therefore, the absence of the term "transgenic" in group I, does not negate the fact that a transgenic product is formed from the claim language of invention I.

The Office Action provides the rationale that inventions I and II are distinct because the product as claimed can be made by another and materially different process, "for example, they can be made by particle bombardment without utilizing *Agrobacterium*"; however, the examiner is limiting the claim scope to the transformation step, which does not constitute the complete invention or process required to make the Guayule product. The claimed transgenic Guayule product of claims 7-9 requires additional controls in light conditions which constitute the complete invention and is not shown to be practiced by the sole recitation of bombardment. A materially different process must suggest a complete invention that would induce shoot elongation and rooting, wherein the examiner provides no statement or evidence as to how bombardment alone accomplishes the complete invention.

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CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 510-559-5731.

Respectfully submitted,

  
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